REMARKS

Reconsideration of the application in light of the following remarks is respectfully requested.

Status of the Claims

Claims 7-11, 14, 15 and 20-26 are pending.

Rejection Under 35 U.S.C. § 103

Claims 7-11, 14, 15 and 20-26 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,381,635 to Hoyer et al. ("Hoyer") in view of U.S. Patent No. 6,578,078 to Smith et al. ("Smith"). Applicants respectfully traverse the rejection.

The Examiner contends that Hoyer discloses most of the features of independent claims 7, 14, 15 and 21. The Examiner acknowledges that Hoyer does not recite "transmitting data representative of the usage to the user by way of a monitor window when the user is connected to any other website on the communication network" as recited in independent claim 7. However, the Examiner contends that Smith (column 11, line 13 through column 12, line 67) discloses that in response to a user's request for a resource, a server looks up the location in a table and forwards a copy of the resource to the user. The Examiner contends that the combination of Hoyer and Smith results in the claimed invention, and states that it would have been obvious to a person of ordinary skill in the art at the time of the invention to combine Hoyer and Smith to achieve the claimed invention.

Applicants submit that Hoyer discloses a method and apparatus for displaying multiple performance measurements of a web site. Hoyer discloses a performance monitor 200 that allows an administrator to assess the performance of Internet web sites (e.g., CPU utilization, web server response time, web server hit count and rate). "The performance monitor 200 includes a client side component 210 and a server side component 225. As depicted, the client side component 210 is coupled to the server side component 225 via the Internet." (Hoyer, column 7, lines 22-29, and Fig. 3.) Hoyer only discloses a client side component receiving performance data from the server side component to which it is connected.

Smith discloses a method for maintaining the integrity of URL references to resources embedded within web sites. The resource is static data (e.g., web pages, documents, etc.), and not usage information. Smith addresses the problems associated with changes in the location of the resources by dealing with broken hyperlinks to the resources that have been moved. When a server receives a message from a client requesting a resource via its URL reference, the server looks up the location of the resource in an indirection table and forwards a copy of the resource to the client. The indirection table contains entries that map a URL to each resource, as documents are moved or deleted, their indirection table entries must be updated. (Smith, column 11, lines 48-63.)

Independent claims 7, 14 and 15 each recite "transmitting data representative of the usage to the user by way of a monitor window when the user is connected to any other website on the communication network." Independent claim 21 recites similar subject matter. The claimed subject matter transmits to the user the usage data **"when the user is connected to any other website."** In contrast, Hoyer discloses a client side component 210 that is coupled to a server side component 225 via the Internet, where the performance measurements being sent to the client side component are **for the web site to which the client is connected.** Similarly, Smith discloses a server that forwards a copy of a resource to the client while the client is connected to the **web site in which the resource is embedded.** Applicants submit that the combination of Hoyer and Smith neither discloses nor suggests transmitting usage data to the user while "connected to any other website," nor does the combination disclose or suggest "a monitor window" as recited in the present claims.

Further, Applicants submit that the combination of Hoyer and Smith does not result in the invention of the present claims. Hoyer and Smith results in a system and method that transmits performance measurements <u>to a client connected to the web site being measured</u>, and will also forward static resources (e.g., web pages and documents) in response to the client activating hyperlinks embedded in the web site, where the combination tracks changes to the location of the resources identified by the hyperlinks in an indirection table. The combination of Hoyer and Smith does not result in a method that transmits "data representative of the usage to the user by way of a monitor window when the user is connected to any other website on the communication network."

Thus, the combination of Hoyer and Smith does not result in the invention of independent claims 7, 14, 15 and 21.

Additionally in considering obviousness, the critical inquiry is whether something in the prior art as a whole suggests the desirability, and thus the obviousness, of making a combination. *In re Newell*, 891 F.2d 899, 901-02, 13 U.S.P.Q. 2d 1248, 1250 (Fed. Cir. 1992). The Examiner must show some objective teaching from the art that would lead an individual to combine the references, *i.e.*, there must be motivation. In particular, "[t]he mere fact that the prior art may be modified in the manner suggested by the examiner does not make the modification obvious <u>unless the prior art suggested the desirability of the modification.</u>" (emphasis added). *In re Fritch*, 972 F.2d 1260, 23 U.S.P.Q. 2d 1780, 1783 (Fed. Cir. 1992). The Court of Appeals for the Federal Circuit has stated: "selective hindsight is no more applicable to the design of experiments than it is to the combination of prior art teachings. There must be a reason or suggestion in the art for selecting the procedure used, other than the knowledge learned from the Applicant's disclosure" *In re Dow Chemical Co.*, 5 U.S.P.Q. 2d 1529, 1531 (Fed. Cir. 1988) (citations omitted).

As demonstrated above, there is no suggestion in Hoyer or Smith to combine these references. Instead, the Examiner has impermissibly relied on the disclosure of the present application "to reconstruct the patentee's claimed invention from prior art by using the patentee's claim as a 'blueprint' when prior art references require selective combination to render obvious a subsequent invention." (*Dow Chemical Co.*, 5 U.S.P.Q. 2d at 1532, *citing Interconnect Planning Corporation v. Feil*, 774 F.2d 1132, 227 U.S.P.Q. 543, 551 (Fed. Cir. 1985).)

Based on the foregoing discussion, Applicants have demonstrated that Hoyer and Smith neither discloses nor suggests, singly or in combination, the invention of independent claims 7, 14, 15 and 21. Therefore, the Examiner has not met the burden of establishing a *prima facie* case of obviousness. Claims 8-11 and 20 depend from independent claim 7. Claims 22-26 depend from independent claim 21. Applicants submit that claims 8-11, 20 and 22-26 are patentable over the combination of Hoyer and Smith for at least the same reasons as their respective base claims. Withdrawal and reconsideration of the rejection is requested.

CONCLUSION

Each and every point raised in the Office Action dated September 27, 2004 have been addressed on the basis of the above amendments and remarks. In view of the foregoing it is believed that claims 7-11, 14, 15 and 20-26 are in condition for allowance and it is respectfully requested that the application be reconsidered and that all pending claims be allowed and the case passed to issue.

If there are any other issues remaining which the Examiner believes could be resolved through a Supplemental Response or an Examiner's Amendment, the Examiner is respectfully requested to contact the undersigned at the telephone number indicated below.

Dated: December 23, 2004   Respectfully submitted,

By

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